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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/647,913

08/25/2003

Yisong Yu

91464/JLT

2332

1333

7590

10/12/2006

PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
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EXAMINER

LEE, SIN J

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/647,913

Applicant(s)

YU ET AL.

Examiner

Sin J. Lee

Art Unit

1752

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

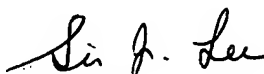
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
Please see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Sin J. Lee
Primary Examiner
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1. Claims 62-67 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al'751, as addressed in Paragraph 3 of Final Office action mailed on July 28, 2006.
2. Claims 1, 2, 4-10, 12, 14-22, 24-32, 34-41, 45-51, 53-59, 69-75 and 77 are allowed as addressed in Paragraph 4 of the Final Office action.

Response to Arguments

3. Applicants argue that there is no reasonable certainty that Inoue's heat-sensitive layer is inherently water-insoluble in the dried state because objective of Inoue's invention is to obtain "good on-machine developability" and for one skilled in the art, developability means removability of unexposed coating from the non-printing hydrophilic substrate surface. However, although Inoue states that after the exposure, during on-machine development, a fountain solution and an ink are supplied onto the lithographic printing plate precursor, Inoue never states that the unexposed portions are being removed by the fountain solution (whereas Inoue expressly states that his water-soluble overcoat layer is designed to be easily removed at the time of printing – see [0093]). Also, it is to be noted that in present Example 1 itself, the imaged plate is mounted onto a press, and then fountain solution and the ink are applied to the plate just as it was done in Inoue.

Applicants also argue that the examples of Inoue provide no polymers prepared using monomers containing carboxyl groups. Thus, applicants argue, the teachings in Inoue amounts to two *extensive laundry lists* of polymers (thus requiring hundreds of hours of experimentation) but omits the critical teaching or direction that would suggest

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putting specific polymers together from each list as applicants have done because Inoue fails to appreciate the value of having unexposed regions that aqueous-insoluble to avoid the need for highly hydrophilic substrates. However, as previously discussed, Inoue already teaches a copolymer of allyl methacrylate and *butyl methacrylate* in his example, and since Inoue also teaches the equivalence of the allyl methacrylate and (meth)acrylic acid as the monomer having heat-reactive group (*please note that Inoue does not give that many examples to choose from for the monomers having heat-reactive group in [0027]*), it would have been obvious to one skilled in the art would to replace the allyl methacrylate with (meth)acrylic acid to make a copolymer of (meth)acrylic acid and butyl acrylate with a reasonable expectation of obtaining a lithographic printing precursor having a good on-the-machine developability. Also, as previously discussed, since Inoue teaches the use of hydrophilic resin (such as cellulose or resin including an amino group) in his heat-sensitive layer in order to improve the on-the machine-developability, it would have been obvious to one skilled in the art to use such hydrophilic resin in Inoue's heat-sensitive layer. Also, it is still the Examiner's position that, in the absence of evidence that proves otherwise, Inoue's heat-sensitive layer coating containing a copolymer of (meth)acrylic acid and butyl methacrylate, hydrophilic resin such as cellulose or resin including an amino group) and a light-to-heat converting agent, would inherently be aqueous-insoluble when dried.

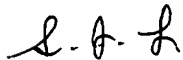
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333.

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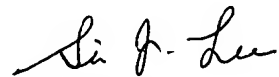
The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Lee
October 4, 2006



SIN LEE
PRIMARY EXAMINER